

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 27, 2004. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 6, 7, 13, 16, 18 and 20 have been amended to further define various features of Applicants' invention. Claims 12 and 20 have been cancelled. Applicants respectfully request reconsideration and favorable action in this case.

### Rejections under 35 U.S.C. § 102

Claims 1-3, 8, 9, and 18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,012,870 issued to Harold W. Dillingham ("Dillingham '870"). Applicants respectfully traverse and submit that Dillingham '870 does not anticipate the invention of Claims 1-3, 8, 9 and 18 because Dillingham '870 fails to disclose, teach or suggest every limitation of the claims.

Dillingham '870 discloses a portable device for mixing pavement repair materials that is to be mounted on a trailer or truck. See Col. 1, lines 7-9. The portable device is provided with heat using burner fired retort tubes or using a "220 volt, 54.75 kw electric emersion heater. See Col. 3, line 55 to Col. 4, line 12. Specifically, electricity is supplied to the emersion heater "from a 220 volt stationary electric outlet or by a 6,000 watt on board generator." Col. 4, lines 10-12.

Applicants note that Dillingham '870 fails to specify how the "on board generator" is powered. It is also unknown what the generator is "on board" with respect to. Because the portable apparatus may be used with either a trailer or a vehicle, it would appear that any such "on board generator" would have to be "on board" with respect to the portable apparatus and have its own power source--independent of either a vehicle or a trailer. Additionally, Applicants note that the Dillingham '870 specifies that it is used to dispense pavement repair material that is "aggregate free" (see abstract) and specifies the usage of the materials ROADPATCH, ROADFLEX and HOTCRETE.

In contrast, Independent Claims 1 and 18 each recites a hydraulically driven on board generator powered by a vehicle (or the use thereof). Because Dillingham '870 does not

disclose, teach or suggest the use of a hydraulically powered on board generator, powered by a vehicle, Dillingham '870 cannot anticipate Independent Claims 1 or 18, or Claims 2-3, 8 or 9 which depend therefrom.

**Rejections under 35 U.S.C. §103**

Claims 12 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dillingham '870 as applied to Claims 1 and 18, and further in view of U.S. Patent 4,861,189 issued to Mitsuo Fukukawa et al. ("Fukukawa et al."). Applicants respectfully traverse. Applicants note that Claims 12 and 19 have been cancelled, but the limitation of Claims 12 and 19 have been incorporated into Independent Claims 1 and 18.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

With respect to the combination of Dillingham and Fukukawa, Applicants note that the paving machine of Fukukawa does not relate to paving machinery that involves heated paving materials. Examiner cites to the "hydraulic pressure generator" (Col. 3, lines 41-42) of Fukukawa as teaching a "hydraulically driven generator."

Applicants first note that the hydraulic pressure generator of Fukukawa is clearly directed at generating and providing **hydraulic pressure** for the hydraulic components of the paving machinery of Fukukawa. However, Fukukawa does not disclose a hydraulically **driven** generator that can provide power to a flameless heating element--Fukukawa is limited

to providing hydraulic pressure to hydraulic components associated with the paving machinery disclosed by Fukukawa.

Accordingly, neither Fukukawa or Dillingham '870 discloses a hydraulically driven generator and therefore fail to disclose, teach or suggest every limitation of currently amended Claims 1 and 18. Additionally, because Fukukawa does not deal with heated paving materials, Applicants submit that it would be unlikely to look to Fukukawa for a power source for heating elements to be used to heat paving materials.

Accordingly, Applicants submit that Claims 1 and 18 are not rendered obvious by the combination of Fukukawa and Dillingham '870.

Claims 13 and 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dillingham '870 in view of Kleiger.

Independent Claim 13 recites, among other elements, a hydraulically driven on board generator powered by the pavement repair vehicle. Because neither Dillingham '870 nor Kleiger disclose a hydraulically driven generator, these references fail to disclose teach or suggest every limitation of Claim 13. Accordingly, the combination of Dillingham '870 and Kleiger cannot render obvious Claim 13 or Claims 15-17 which depend therefrom.

Claims 6 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dillingham '870. Claims 4, 5, and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over 870 Dillingham as applied to Claim 1, and further in view of U.S. Patent 5,988,935 issued to Harold W. Dillingham ("Dillingham '935"). Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over 870 Dillingham as applied to Claim 1, and further in view of U.S. Patent 5,419,654 issued to Scott P. Kleiger ("Kleiger"). Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over 870 Dillingham and Kleiger as applied to Claim 13, and further in view of Dillingham '935.

Applicants submit that Claims 4-7, 10, 11, 13, 14 and 20 depend from Claims that have been placed in condition for allowance. Accordingly, the cited references cannot render obvious these Claims.

Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. §103, and full allowance of Claims 1, 4-7, 10, 11, 13-18 and 20.

### CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims, as amended.

Applicants enclose a Petition for Extension of Time (one month) under CFR 1.136(a) and a check in the amount \$60.00 for the extension fee.

Applicants believe there are no other fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2548.

Respectfully submitted,  
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